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DEC 10 2007

In re Application of  
MURRAY FIGOV  
Application No. 10/538,489  
Filed: December 8, 2003  
Attorney Docket No. 91255JLT

# DECISION ON PETITION TO REVERSE THE EXAMINER UNDER 37 C.F.R. § 1.181

This is a decision on the petition filed July 20, 2007, requesting the Group Director to exercise her supervisory authority to reverse the examiner's refusal to enter applicant's second amendment filed under 37 C.F.R. § 1.116 amendment (rule 116 amendment) that was submitted on June 12, 2007 and to direct entry of the amendment.

The petition is granted to the extent that the examiner's action has been reviewed but denied as to making any change thereto.

## BACKGROUND

A preliminary amendment was filed June 9, 2005. Original claims 1-39 were cancelled and new claims 40-70 were added.

A restriction requirement Office action was mailed May 24, 2006, requiring restriction between two groups: Group I, claims 1-30 and 38-39, a lithographic printing blank, a method of producing said blank, and a wet lithographic printing process using said blank, and Group II, claims 31-37, an ink-jet ink.

A response to the restriction requirement was timely filed on June 26, 2006 and Group I was elected. Applicant stated that the election was made with traverse but did not present any arguments. Further, applicant did not bring to the examiner's attention that a preliminary amendment had been filed and that claims 40-70 are now pending in the application.

A non-final Office was mailed August 14, 2006. The examiner held the election of Group I as having been made without traverse since no arguments were presented with the response to the restriction requirement. Claims 1-30 and 38-39 was rejected and claims 31-37 were withdrawn from consideration as being drawn to a nonelected invention.

On September 20, 2006 a new non-final Office action was mailed. Claims 40-70, as presented in the preliminary amendment, were subject to a restriction requirement: Group I, claims 39[sic]40-61 and 69-70, a lithographic printing blank, a method of producing said blank, and a wet lithographic printing process using said blank, and Group II, claims 62-68, an ink-jet ink.

The examiner treated the response to the restriction requirement filed on June 26, 2006 as an election of Group I, claims 40-61 and 69-70 and reexamined the application. Claims 40-61 and 69-70 was rejected and claims 62-68 were withdrawn from consideration as being drawn to a nonelected invention.

A response to the non-final Office action was filed on December 18, 2006. Claims 54, 56 and 61 were amended, claim 60 was cancelled and new claim 71 added. Applicant presented arguments traversing the rejections and requested reconsideration.

A Final Office action was mailed March 22, 2007 rejecting claims 40-59, 61 and 69-71. After addressing applicant's arguments, it was stated that applicant's amendment necessitated the new grounds of rejection and the action was made final.

A rule 116 amendment was filed on May 15, 2007, with an amendment to claims 40, 54 and 69 to include the subject matter of claims 46-48, 51 and 52. Claims 46-48, 51 and 52 thereafter were cancelled.

An Advisory action was mailed May 25, 2007, indicating that the rule 116 amendment would not be entered because the amendments raised new issues that would require further consideration and/or new search. The examiner stated that the added limitations in the independent claims requiring a range of concentrations of the components raised new issues.

A second rule 116 amendment was filed on June 12, 2007, with an amendment to claim 40 to include the subject matter of claims 46-48, 51 and 52. Claims 46-48, 51 and 52 was cancelled. Claims 54-70 were also cancelled in order to expedite allowance of the application.

An Advisory action was mailed July 10, 2007, indicating that the second rule 116 amendment would not be entered because the proposed amendments raised new issues that would require further consideration and/or new search. The examiner stated that new issues were raised because amended claim 40 specified that the polyvinyl alcohol (PVA) and polyacrylic acid (PAA) both be present at a certain percentage.

Petitioner seeks relief by filing a petition under 37 C.F.R. § 1.181 requesting that the second rule 116 amendment be entered.

A Notice of Appeal was filed on September 25, 2007.

### REGULATIONS AND PRACTICE

37 C.F.R. § 1.116(a) and (b) state that:

- (a) An amendment after final action must comply with § 1.114 or this section.
- (b) After a final rejection or other final action (§ 1.113) in an application or in an ex

parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

- (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
- (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
- (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

M.P.E.P. § 714.12 states in part that:

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments >filed after a final rejection, but before or on the date of filing an appeal,< complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR § 1.116(b).

#### OPINION

Petitioner asserts that his second rule 116 amendment submitted on June 12, 2007 should be entered as it will further prosecution and simplify issues for any appeal. Petitioner further asserts that the examiner has sufficiently considered the subject matter added to claim 40 so that no new issue is raised requiring a new search or consideration.

Petitioner points to several provisions of the Manual of Patent Examination Procedure (M.P.E.P.) that provide guidance for this situation as it gives directions to examiners in the searching and consideration of claimed subject matter.

M.P.E.P. § 904.01: "During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification".

M.P.E.P. § 904.02 (second paragraph): "The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed".

M.P.E.P. § 904.02(a) (second paragraph): "The field of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed".

M.P.E.P. § 904.03 (first paragraph): "It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most

detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment".

M.P.E.P. § 904.03 (last paragraph): In all references considered, including nonpatent, foreign patents, and domestic patents, the examiner should study the specification or description sufficiently to determine the full value of the reference disclosure relative to the claimed or claimable subject matter.

Petitioner concludes from the directions given to examiners in searching and consideration of claimed subject matter, the features of amended claim 40 were presumably searched and considered individually. Petitioner also states that it is clearly reasonable to expect combinations of the ranges of components to be claimed, as in amended claim 40, particularly in view of the teaching in applicant's examples as well as the text of the general disclosure.

A review of the file record indicates that second rule 116 amendment raises new issues which would require further consideration and/or search by the examiner if entered. The individual use of the ranges of amounts of components as well as their combinations as presented in amended claim 40 are not limitations that might reasonably have been expected to be claimed. For example, the hydrophilic or oleophilic composition in the specified ranges was not previously presented. Entry of amended claim 40 would avoid the rejections and require new considerations.

Further, the teaching of applicant's examples as well as the text of the general disclosure would not have provided the examiner a clear reasonable expectation of the combinations of the ranges of components as in amended claim 40. Applicant does not claim the specific compositions of examples 1-3, presumably embodiments of the invention. No reason is offered to indicate why the amendment was not or could not be presented earlier.

Petitioner's attention is also directed to the attached memorandum from the Deputy Commissioner for Examination Policy, titled "Clarification of Second Action Final Rejection Practice with Respect to Claims Drafted Using Alternative Language," dated January 24, 2007. The last paragraph in reference to M.P.E.P. § 904.02 states "[a]n examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection except in very limited circumstances (e.g., where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. §112 second paragraph)."

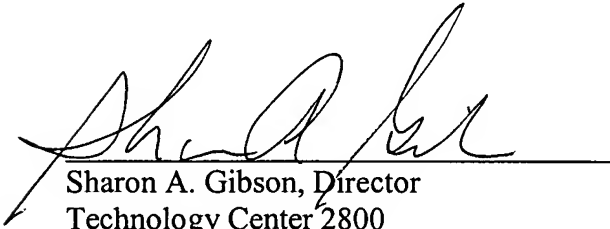
### CONCLUSION

The second rule 116 amendment clearly raises new issues which would require further consideration by the examiner. No evidence has been presented that amended claim 40 places the application in better form for appeal. Neither has applicant presented good and sufficient reasons why the amendment is necessary and could not be earlier presented. Further, amended claim 40

does not *prima facie* put the application in condition for allowance. Entry of the amendment was properly refused by the examiner as provided for under the above quoted Rules and M.P.E.P. sections.

The petition is DENIED. Entry of the amendment was properly refused by the examiner as provided for under the above quoted Rules and M.P.E.P. sections.

Inquiries regarding this decision should be directed to Jose' G. Dees at 571-272-1569.



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'See Attachment'